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JAN 26 2007

Amendment and Response

Applicant: Lauinger, Geoffrey A., et al.

Serial No.: 10/690,439

Filed: October 21, 2003

Docket No.: 10388US01

Title: A METHOD OF MANUFACTURING A MEDIA REFERENCE SURFACE FOR USE IN A FLEXIBLE
DATA STORAGE CARD**REMARKS**

The following remarks are made in response to the Non-Final Office Action mailed October 30, 2006. In that Office Action, claim 22 was rejected under 35 U.S.C. § 112, second paragraph, and claims 1-6, 14-15 and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Enoch, U.S. Patent No. 2,662,357 ("Enoch") in view of J.W. Wenner, U.S. Patent No. 3,150,939 ("Wenner"). Claims 23-32 were previously withdrawn from consideration.

In addition, other of the dependent claims were rejected under 35 U.S.C. § 103(a) over the combination of Enoch and Wenner in view of other cited references, including: claim 7 rejected as unpatentable over the combination of Enoch and Wenner and further in view of B. Solow, U.S. Patent No. 2,743,506 ("Solow"); claim 13 rejected as unpatentable over the combination of Enoch and Wenner and further in view of Hida et al., U.S. Patent No. 4,841,134 ("Hida"); claims 11-12 and 16-17 rejected as unpatentable over the combination of Enoch and Wenner and further in view of J.F. Steger et al., U.S. Patent No. 3,583,887 ("Steger"); and claim 22 rejected as unpatentable over the combination of Enoch and Wenner and in further view of Scheffel, U.S. Patent No. 3,935,431 ("Scheffel").

With this Response, claim 22 has been amended and claim 33 is newly presented. Claims 1-22 and 33 are pending in the application and presented for consideration and allowance.

Claim Rejections under 35 U.S.C. § 112

Claim 22 was rejected under 35 U.S.C. § 112, second paragraph. With this Response, claim 22 has been amended to provide a media reference surface as claimed in claim 1, where each media reference surface is configured for attachment to an interior housing surface of the flexible data storage card. The trademark word "StorCard®" has been deleted from claim 22, such that amended claim 22 is believed to be definite under 35 U.S.C. § 112, second paragraph.

It is respectfully requested that the rejection to claim 22 be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 1-6, 14-15 and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over

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Enoch in view of Wenner.

The Office Action concedes at page 3 that Enoch does not disclose a metal sheet including at least one side having an optically smooth surface characterized by an average surface roughness not greater than 8 micro-inch. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time the pending invention was made to have modified Enoch to include an average surface roughness as taught by Wenner to improve a surface of magnetic recording media. Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify or combine the reference teachings. Second, there must exist a reasonable expectation of success. Third, the references must teach or suggest all of the claim limitations. MPEP § 2143.

A *prima facie* case of obviousness cannot be established if a suggestion or motivation to combine the cited references does not exist. A purported motivation or suggestion to combine cited references can be rebutted if it can be shown that one of the cited references teaches away from the other of the cited references. MPEP § 2143.02.

Enoch discloses a method of forming an array of thin magnetic data storage elements. The magnetic data storage elements relate to computer memory, where each of the magnetic storage elements has a magnetic condition that can be switched from one state of magnetic remanence to another state by a suitable current-carrying conductor. In this regard, Enoch discloses at column 1, lines 13-17 that: "For an element to be suitable for use in a memory, the following properties are required: 1. The materials should have a rectangular hysteresis loop; 2. the coercivity of the material should preferably be less than 10 oe." (Emphasis added)

Enoch additionally discloses from column 1, line 61 to column 2, line 44 that a sheet 1 of magnetic material is formed to have holes 2. The sheet 1 is placed in a furnace and annealed in the presence of a "sufficiently strong magnetic field" such that lines of easy magnetization will be formed along the lines of force of the magnetic field. Enoch further discloses that the sheet 1 is removed from the magnetic field and bonded to a substrate 4. Enoch discloses at column 2, lines 40-44 that after an etching and removal process, all of the sheet 1 is removed except for

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small rings 5 which form the data storage elements bonded to substrate 4. With reference to Enoch at Figure 3, Enoch provides rings 5 each including "lines of easy magnetization" that are bonded to substrate 4. Thus, the remaining rings 5 of Enoch are magnetized.

In contrast, Wenner provides at column 2, lines 35-40 that the principle of his invention is predicated on a magnetizable layer that is characterized by a high coercivity and a high surface smoothness. In this regard, Wenner discloses at column 3, lines 8-15 that the magnetizable metal is provided with a surface roughness of no greater than 4 mico-inches and provided with a coercivity of at least 375 Oe (Oersteds).

It is respectfully submitted that a *prima facie* case of obviousness cannot be established since Enoch requires a low coercivity of less than 10 Oersteds, and Wenner provides a high coercivity of at least 375 Oersteds. Consequently, one of ordinary skill in the art would have no motivation to combine the disclosure in Enoch, **requiring** a coercivity of less than 10 Oe, with the divergent disclosure of Wenner having a coercivity of at least 375 Oersteds. Independent claim 1 is not rendered obvious under 35 U.S.C. § 103(a) as unpatentable over Enoch in view of Wenner for at least the reason that Enoch teaches away from combination with Wenner.

It is respectfully requested that the rejections to independent claim 1, and claims depending from claim 1, be withdrawn since all such rejections depend upon a combination of Enoch and Wenner.

In addition, the specification of the pending invention provides at page 3, lines 2-9 that a media reference surface is provided on an interior side of a card top of a flexible data storage card. The specification specifically provides that: "The media reference surface is generally an elongated piece of non-magnetic metal attached to the card top interior."

The sheet 1 of Enoch is a highly magnetized annealed sheet. Wenner provides at column 2, lines 33-35 "the invention relates to that type of record carrier wherein the recording medium is a layer of magnetizable metal." In this regard, **each of the cited references is directed to a particular type of sheet that is fundamentally ill-suited for formation into a media reference surface for use in a flexible data storage card.** Consequently, even if the cited references were impermissibly combined, the resulting sheet would be a highly magnetized sheet

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that could not function as a media reference surface, since a magnetized media reference surface would undesirably interfere with data stored on media disks (See FIG. 1 of the instant application). For this additional reason, it is respectfully submitted that a *prima facie* case of obviousness cannot be established based upon Enoch in view of Wenner, and it is respectfully requested that the rejections to independent claim 1, and all claims depending from claim 1, be withdrawn.

Dependent claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over Enoch in view of Wenner and further in view of Solow. Solow is directed to a method of manufacturing rectifier cells. Even if one were to assume that Solow could be combined with Enoch and Wenner, the disclosure in Solow fails to cure the deficiencies noted above related to the primary references. Thus, a *prima facie* case of obviousness cannot be established over Enoch in view of Wenner and further in view of Solow, and it is respectfully requested that the rejection to claim 7 be withdrawn.

Dependent claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over Enoch in view of Wenner and further in view of Hida. Hida is cited as disclosing photo etching of an integrated circuit card component. Even if one were to assume that Hida could be combined with Enoch and Wenner, the disclosure in Hida fails to cure the deficiencies noted above related to the primary references. Thus, a *prima facie* case of obviousness cannot be established over Enoch in view of Wenner and further in view of Hida, and it is respectfully requested that the rejection to claim 13 be withdrawn.

Dependent claims 11-12 and 16-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Enoch in view of Wenner and further in view of Steger. Steger is cited as disclosing a method of cold forming magnesium oxide coated compositions. Even if one were to assume that Steger could be combined with Enoch and Wenner, the disclosure in Steger fails to cure the deficiencies noted above related to the primary references. Thus, a *prima facie* case of obviousness cannot be established over Enoch in view of Wenner and further in view of Steger, and it is respectfully requested that the rejection to claims 11-12 and 16-17 be withdrawn.

Dependent claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable over Enoch in

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view of Wenner and in further view of Scheffel. Scheffel is cited as disclosing a media reference surface configured for use in a flexible data storage card. It is believed that flexible data storage cards, as provided for in the instant specification, did not exist in 1974 when Scheffel was filed. In this regard, Scheffel is directed to rectangular data cards suited for the storage and reading of binary data, and not to flexible data storage cards as defined by the pending claims. However, even if a combination of Scheffel with Enoch and Wenner were to be appropriate, a position applicants do not concede, it is respectfully submitted that Scheffel fails to cure the deficiencies of Enoch and Wenner. It is respectfully requested that the rejection to claim 22 as unpatentable over Enoch in view of Wenner in view of Scheffel be withdrawn.

Based on the arguments above, it is believed that independent claim 1 is non-obvious under 35 U.S.C. § 103, such that claims 2-22 that depend from claim 1 must also be non-obvious. MPEP § 2143.03.

Allowable Subject Matter

The Examiner objected to claims 8-10 and 19-20 as being dependent upon a rejected base claim, but deemed the claims to be allowable if rewritten in independent form, which is noted with appreciation.

New Claim 33

Claim 33 is newly presented to particularly point out and distinctly claim subject matter believed to further define patentably distinct independent claim 1. Support for the language of claim 33 is located throughout the specification, in particular at least in FIGS. 4-6B.

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CONCLUSION


Applicants respectfully submit that pending claims 1-22 and 33 recite patentable subject matter, are in form for allowance, and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-22 and 33 is respectfully requested.

A fee of \$50 is required under 37 C.F.R. § 1.16(i) for one additional claim in excess of 20. If other fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 09-0069.

The Examiner is invited to telephone the Applicants' representative at the below-listed number to facilitate prosecution of this application.

Respectfully submitted,

Date: 1/26/07


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